

AUG 10 2007

**PRE-APPEAL BRIEF REQUEST
FOR REVIEW**MAIL STOP AF
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Application Number	09/800,997
Filing Date	March 8, 2001
First Named Inventor	Target
Art Unit	3621
Examiner Name	K. Abdi
Attorney Docket No.	47004.000107

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this appeal.

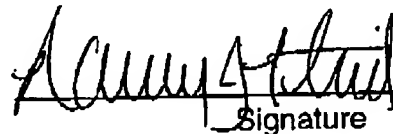
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided

I am the:

☐ Applicant/Inventor


Signature

☐ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96).

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Registration No. if acting under 37 CFR 1.34 _____

August 10, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE RECEIVED
CENTRAL FAX CENTER

Application Number : 09/800,997 Confirmation No.: 6654
Applicant : John W. Torget et. al.
Filed : March 8, 2001
Title : System and Method for Remotely Generating Instruments
TC/Art Unit : 3621
Examiner: : Kambiz Abdi

AUG 10 2007

Docket No. : 47004.000107
Customer No. : 21967

Mail Stop: AF
Commissioner for Patents
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Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below.

This application was filed March 8, 2001, claiming priority to a non-provisional application filed on December 1, 2000. The claims were subject to a restriction requirement dated September 9, 2004, pursuant to which claims 1-28 and 66 were elected for prosecution. Claims 1-3, 10-11, 15-16, 18-20, 25, 27 and 66 were rejected under 35 U.S.C. § 102(a) under European Patent Appln. No. EP 1-014-318 A2 to Yamaguchi ("Yamaguchi") in Office Actions dated November 19, 2004 and June 13, 2005. Claims 4-9, 12-13, 17, 21-24, 26 and 28 were rejected under 35 U.S.C. § 103(a) Office Actions over Yamaguchi in view of U.S. Patent No. 6,390,362 to Martin ("Martin"). Claim 14 was rejected over Yamaguchi in view of U.S. Patent No. 5,432,506 to Chapman ("Chapman"). The Examiner concluded that an affidavit filed pursuant to 37 C.F.R. § 1.131 on April 7, 2005 was ineffective to overcome the Yamaguchi reference. Following an Amendment after Final Rejection filed August 18, 2005 and receipt of an Advisory Action dated September 1, 2005, Applicants filed a Request for Continued

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Examination ("RCE") on September 23, 2005. The pending claims were again rejected in an Office Action dated October 18, 2005 as allegedly anticipated by Yamaguchi and as allegedly unpatentable over Yamaguchi in view of Martin and Yamaguchi in view of Chapman. Newly added claims 69-72 were subject to a restriction requirement.

Applicant canceled claims 3, 20 and 69-72 in an Amendment and Response dated December 20, 2005. A Final Rejection issued on March 10, 2006 in which claims 1, 17, 18, 28 and 66 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. All pending claims were again rejected as allegedly anticipated by Yamaguchi, and as allegedly unpatentable over Yamaguchi in view of Martin, and Yamaguchi in view of Chapman. Applicants filed an Amendment after Final Rejection on May 10, 2006. Following receipt of an Advisory Action dated May 25, 2006, Applicants filed a second Request for Continued Examination on June 12, 2006. In an Office Action dated August 11, 2006, the Examiner maintained the rejections over Yamaguchi in view of Martin and Yamaguchi in view of Chapman; withdrew the rejection for alleged lack of enablement; and rejected claims 1, 17, 18, 28 and 66 under 35 U.S.C. § 112, second paragraph as allegedly indefinite. The Examiner also withdrew the anticipation rejection of claims 1-3, 10-11, 15-16, 18-20, 25, 27 and 66 over Yamaguchi, but then rejected these claims under 35 U.S.C. § 103(a) over Yamaguchi. An interview was held on January 3, 2007 but no agreement was reached. Applicants filed an Amendment and Response on February 6, 2007. A Final Rejection was issued on May 1, 2007 in which the rejection under 35 U.S.C. § 112, second paragraph was withdrawn. However, the rejections under 35 U.S.C. § 103(a) over Yamaguchi, Yamaguchi in view of Martin and Yamaguchi in view of Chapman were maintained.

To date, Applicants have maintained that each of the rejections in the Office Actions and Final Rejections fail to properly address each and every claim limitation of the rejected claims. Accordingly, rather than proceeding with an expensive and lengthy appeal, Applicants respectfully request that the Office, following consideration of the remarks below, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, then Applicants request that the Office either issue a proper office action stating a thoughtful basis for rejection that addresses each and every claim limitation or allow this application to proceed to appeal.

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Claims 1, 2, 10-11, 15-16, 18-19, 25, 27 and 66 stand rejected under 35 U.S.C. § 103(a) over Yamaguchi; claims 4-9, 12-13, 17, 21-24, 26 and 28 stand rejected under 35 U.S.C. § 103(a) over Yamaguchi in view of Martin; and claim 14 stands rejected under 35 U.S.C. § 103(a) over Yamaguchi in view of Chapman. Yamaguchi, either alone or in combination with the cited references, does not disclose the limitation of independent claims 1, 17, 18, 28 and 66 of a first security image transmitted in electronic form as part of a composite image such that, when the composite image is printed on a medium, the first security image is readable by man or machine but is *not* readable by man or machine on a photocopy of the instrument. These deficiencies are not resolved by Martin or Chapman.

The arguments raised by the Examiner fail to address the disclosure of this claim limitation in the cited references.¹ The Examiner first argues that "[P]aragraph [0087] . . . clearly teaches a readable image is used for over lay that is readable on the instrument as printed as well as the instrument has none readable data hidden within barcodes as well as the readable watermark printed on the instrument (See Yamaguchi figures 2-5, 9, 22, and 23, and related text)." [sic] See Final Rejection dated May 1, 2007 at ¶ 5. Para. [0087] discusses FIG. 22, which depicts composition of data that is transmitted to a user to print a ticket according to the method of Yamaguchi. In FIG. 22, "ticket image data" 21, "security data" 22 and "key image data" 24 are used to form "ticket print data" 23. "Ticket print data" 23 is used to make "ticket display data" 25, in which "security data" 22 are "embedded invisibly." "Ticket print data" 23 and "ticket display data" 25 are transmitted to a user. Image 14 (the same as "ticket image data" 21) is displayed and also appears on a ticket when printed by the user (see para. [0089]). Embedded "security data" 22 are revealed when "key image data" 24 is superimposed on the printed ticket.

Yamaguchi, however, discloses only two sources of data that are used to form the composite image - "security data" 22 and "ticket image data" 21 - and *both* of these are *readable*

¹ The Examiner mischaracterizes the "thrust" of Applicants' argument as allegedly "the first security image (watermark) is readable on the instrument printed on the medium." See Office Action, August 11, 2006 at ¶ 4; Final Rejection, May 1, 2007 at ¶ 5. Applicants repeatedly have stated that the "thrust" of their argument is that "Yamaguchi does not disclose any single data item that is *readable*, when printed on a medium, where that *same* data is then *not readable* when copied." Amendment and Response, February 6, 2007 at p. 17.

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on a photocopy of the printed ticket.² Yamaguchi expressly discloses in Para. [0082] that "security data" 22 are embedded in the invisible state to the sight of man in the ticket as printed, but are readable by machine both in the printed ticket *and in a photocopy of the printed ticket*:

As described above, by detecting the presence of the security data 22 embedded in the used ticket 14, the genuineness of the ticket 14 can be easily judged. For instance, even if the ticket 14 was given to a third person and illegally copied using a color copying machine, the history of that ticket, for instance, when, where and who issued it can be seen as the security data 22 contains a inquiry serial number and an illegal route can be detected easily. (emphasis added).

Applicants made this express argument previously, but the Examiner did not address this in the Final Rejection. *See* February 6, 2007 Amendment and Response at p. 10. This disclosure makes clear that Yamaguchi does *not* disclose a first security image which is transmitted in electronic form as part of a composite image such that, when the composite image is printed on a medium, the first security image is readable by man or machine but is not readable by man or machine on a photocopy of the instrument, as required by claims 1, 17, 18, 28 and 66.

Next, the Examiner argues that "it is clearly stated that the logo mark is used as a readable as well as not a readable state as to be used as a "security image." *See* May 1, 2007 Final Rejection at ¶ 5. Paras. [0034]-[0036] disclose only that the "logo mark" seen in FIGS. 3-5 is included in both the "ticket image data" 21 *and* the "security data" 22. According to para. [0082], however, the "logo mark" is readable in a photocopy of the ticket, because "ticket image data" 21 and "security data" 22 can be detected in a photocopy. This is consistent with the discussion of FIG. 22, *supra*, that the logo mark in "security data" 22 are readable in a photocopy of the ticket, and this section of Yamaguchi does not add further disclosure than para. [0087]. The arguments raised in ¶¶ 8, 10, 13 of the May 1, 2007 Final Rejection are similarly inapposite.

The Examiner also claims that Applicants have admitted that it has been known to print images on documents that cannot be copied. *See* May 1, 2007 Final Rejection at p. 6, referring to p. 9, 2nd paragraph of the May 10, 2006 Amendment and Response and the April 7, 2005 Declaration under 37 C.F.R. 1.131. However, Applicants' remarks in those citations are

² There is no reasonable basis to believe that "ticket display data" 25 which are the same as the image 14 as printed on the ticket, would *not* remain readable to man and machine in a photocopy of the ticket. Thus, the only other data that could meet the "first security image" limitation of the claims at issue is "security data" 22.

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directed to inks that cannot be copied and do not disclose the limitation at issue.

Additionally, the Examiner references "watermarks" as meeting this limitation. First, the Examiner states that paper watermarks are "readable by holding the instrument against the light," and that "once the instrument has been copied the paper watermark does not copy or printing holograms that are difficult to copy (See Martin '362 column 2, lines 11-46)." May 1, 2007 Final Rejection at ¶ 9; *see also* ¶ 6. Paper watermarks, however, are not transmitted electronically as part of a composite image. *See* February 17, 2007 Amendment and Response at p. 18. The Examiner next asserts that fragile watermarks are known in the art to prevent copying of an instrument and that this would be an obvious modification of Yamaguchi. *See* May 1, 2007 Final Rejection at ¶ 6; *see also* ¶ 9. The use of fragile watermarks as "security data" 22 would render Yamaguchi inoperable, however, because "security data" 22 must be readable if the ticket is copied. *See* Yamaguchi at para. [0082]; February 17, 2007 Amendment and Response at p. 11. Fragile watermarks would not work for the intended purpose in Yamaguchi and therefore do not form a *prima facie* case of obviousness of the rejected claims.

Finally, the Examiner raises for the first time that the claims, as written, are conditional. May 1, 2007 Final Rejection at ¶ 7. Applicants respectfully submit that this rejection has never been previously raised, and they have not had an opportunity to meet this rejection.

An appeal on the basis that each and every limitation of independent claims 1, 17, 18, 28 and 66 is not disclosed in Yamaguchi will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by Applicants when the grounds are so clearly improper.

Respectfully submitted,

Date: August 10, 2007

By: 

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